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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,738	01/09/2002	Wolfgang Brauer	Mo-6931/LeA 35,798	6549

157 7590 05/29/2003

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,738

Applicant(s)

BRAUER ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. In view of applicants' response of May 2, 2003, the finality of the previous Office action has been withdrawn.
2. Claims 3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have closed claim 1 to the inclusion of additional components and processing steps; therefore, the position is taken that the prepolymer process of claim 3 and the auxiliary substance of claim 6 are excluded by the language of claim 1. Accordingly, claims 3 and 6 fail to properly further limit the subject matter of claim 1.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah ('852) or WO 99/14252.

The references disclose a thermoplastic polyurethane derived from a continuous reaction of diisocyanate, polyether polyol, and 1,4-di-(2,2'-hydroxyethyl)-hydroquinone, in the presence of stannous octoate. See column 4, lines 6 and 36; column 5; and examples within Shah. See pages 25-27 and 31 within WO 99/14252. Since the disclosed compositions and instantly claimed composition are derived from equivalent reactants, the position is taken that applicants' claimed glass transition temperature is an inherent feature of the disclosed compositions.

5. Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Vedula et al. ('059).

Vedula et al. disclose a thermoplastic polyurethane derived from the reaction of diisocyanate, polyether polyol, and 1,4-di-(2,2'-hydroxyethyl)-hydroquinone, in the presence of stannous octoate. See columns 1-3. Since the disclosed composition and instantly claimed composition are derived from equivalent reactants, the position is taken that applicants' claimed glass transition temperature is an inherent feature of the patentees' composition. In accordance

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with Office practice, product-by-process claims are examined as product claims, and applicants have not established that the process features of claim 1 yield a patentably distinct product.

6. Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vedula et al. ('059) in view of Shah ('852) or WO 99/14252.

As aforementioned within paragraph 5, Vedula et al. disclose thermoplastic polyurethanes, produced from reactants that meet applicants' reactants; however, the exemplified composition is silent with respect to the use of a continuous process and is further silent with respect to the use of a prepolymer process. However, the position is taken that the use of continuous processes and prepolymers within such processes in the production of a thermoplastic composition was well known and conventional at the time of invention. This position is supported by the teachings of the secondary references. See paragraphs 3 and 4 for discussion of the secondary references. Therefore, the position is taken that it would have been obvious to utilize such known processing techniques to produce the composition of Vedula et al., so as to arrive at a process having the advantages inherent to continuous processes and prepolymeric processes.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent
May 27, 2003


RABON SERGENT
PRIMARY EXAMINER